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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200450
Party	Defendant Dropbox, Inc.
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Submission	Motion to Consolidate
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Date	02/07/2012
Attachments	Renewed Motion to Consolidate - Box.pdf (8 pages)(21925 bytes) Slafsky Decl ISO Renewed Motion to Consolidate - Box.pdf (3 pages)(8934 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BOX.NET, INC.,)	Opposition No: 91200450
)	
Opposer,)	
)	APPLICANT’S RENEWED MOTION
v.)	TO CONSOLIDATE
)	
DROPBOX, INC.,)	
)	Serial No. 77817716
Applicant.)	
)	
)	

A. INTRODUCTION

Applicant Dropbox, Inc. (“Dropbox”) hereby moves, pursuant to Fed. R. Civ. P. 42(a) and TBMP § 511, to consolidate Opposition No. 91200450 and Opposition No. 91201367 because the two proceedings involve common questions of fact and law and the same disputed trademark application. In particular, both proceedings involve similar challenges to Dropbox’s federal intent-to-use trademark application for the mark DROPBOX. The two opposers — YouSendIt, Inc. (“YouSendIt”) and Box.net, Inc. (“Box.net”) — each allege superior rights to the mark DROPBOX, claiming priority and likelihood of confusion. Dropbox denies the opposers’ substantive allegations and asserts affirmative defenses of laches, waiver, acquiescence, and estoppel in both of the proceedings.

Dropbox also requests that the Board reset the dates for the discovery and trial periods in these proceedings and that the Board suspend the proceedings pending disposition of this motion.

As set forth below, consolidating the proceedings would result in significant savings of time and expense for the parties, prevent a wasteful duplication of effort, and create judicial economy for the Board. It would also avoid inconsistent decisions by the Board.

Applicant has met and conferred with counsel to the two opposers, pursuant to the Board's order dated January 13, 2002.

B. PROCEDURAL POSTURE

Both of the proceedings are at an early stage: the parties have filed their pleadings and no discovery has been served. These proceedings — together with a third, related proceeding — are summarized as follows:

1. YouSendIt v. Dropbox

YouSendIt filed its Notice of Opposition on August 26, 2011. The Notice of Opposition alleges that YouSendIt owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its Answer on September 23, 2011, denying the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence, and estoppel.

2. Box.net v. Dropbox

Box.net filed its Notice of Opposition on June 29, 2011. The Notice of Opposition alleges that Box.net owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its Answer on August 5, 2011, denying the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence, and estoppel.

3. Officeware v. Dropbox

The Board has suspended consideration of an opposition filed by Officeware Corporation (“Officeware”) against the same application to register the DROPBOX mark. Officeware's June 29, 2011 Notice of Opposition alleges that Box.net owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its

Answer on August 5, 2011, denying the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence, and estoppel.

The basis for the Board's suspension is a pending federal district court trademark lawsuit filed by Officeware against Applicant.¹

C. THE BOARD'S PRIOR ORDER

Applicant previously moved for consolidation of these proceedings together with the Officeware proceeding (before the Officeware proceeding was suspended). None of the opposers filed papers in opposition to the motion. By order dated January 13, 2012, the Board nonetheless denied the motion "at this time," noting the Board's decision to suspend the Officeware proceeding and also that the parties had not yet met and conferred about the details of consolidation.

D. THE MEET AND CONFER PROCESS

Applicant's counsel met and conferred with counsel to YouSendIt on January 30, 2012. Applicant's counsel communicated its intent to file this motion. Applicant's counsel stated its view that having both oppositions proceed through discovery and to trial on the same schedule, and then having both oppositions heard by the same Board panel, would be most efficient and would help mitigate the risk of inconsistent decisions by the Board. Applicant's counsel also stated its view that designation of lead opposition counsel for both oppositions is not necessary. In response, counsel to YouSendIt stated its position that it does not intend to oppose this motion (but at the same time it would not enter into any stipulation). Slafsky Dec. ¶ 2.²

¹ Dropbox's motion to stay the federal district court lawsuit is under submission.

² Applicant is submitting with this motion the February 7, 2012 declaration of John L. Slafsky ("Slafsky Dec.").

Applicant's counsel met and conferred with counsel to Box.net on February 1, 2012. Applicant's counsel communicated its intent to file this motion. Applicant's counsel stated its view that having both oppositions proceed through discovery and to trial on the same schedule, and then having both oppositions heard by the same Board panel, would be most efficient and would help mitigate the risk of inconsistent decisions by the Board. Applicant's counsel also stated its view that designation of lead opposition counsel for both oppositions is not necessary. Counsel to Box.net stated that he would need further direction from his client. Applicant's counsel subsequently followed up with counsel to Box.net concerning Box.net's position, but Box.net did not respond or otherwise state a position. Slafsky Dec. ¶ 3.

E. DISCUSSION

The Board may consolidate multiple actions where the actions involve common questions of fact and law. Fed. R. Civ. P. 42(a); TBMP § 511. In determining whether to consolidate cases, the Board weighs the savings in time, effort, and expense which may be gained from consolidation against any prejudice or inconvenience that consolidation could cause. TBMP § 511. Identity of the parties is not required. *Id.*; *see also* Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure §§ 2383, 2384 (3d ed. 2009). Nor is consent of the parties. Wright & Miller §§ 2383, 2384.

These proceedings involve common questions of fact and law because they each involve questions related to (i) priority of rights to the mark DROPBOX, (ii) distinctiveness of the mark DROPBOX, (iii) the likelihood of confusion, if any, arising from Dropbox's application to register the mark DROPBOX, and (iv) the defenses of laches, waiver, acquiescence, and estoppel. The Board will apply to each of these proceedings the same likelihood of confusion

factors set forth by the Federal Circuit in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), namely:

- i. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- ii. The similarity or dissimilarity and nature of the goods or services.
- iii. The similarity or dissimilarity of established, likely-to-continue trade channels.
- iv. The conditions under which and the buyers to whom sales are made, that is, 'impulse' vs. careful, sophisticated purchasing.
- v. The fame of the prior mark (sales, advertising, length of use).
- vi. The number and nature of similar marks in use on similar goods.
- vii. The nature and extent of any actual confusion.
- viii. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- ix. The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark).
- x. The market interface between applicant and the owner of a prior mark.
- xi. The extent to which applicant has a right to exclude others from use of its mark on its goods.
- xii. The extent of potential confusion, *i.e.*, whether de minimis or substantial.
- xiii. Any other established fact probative of the effect of use.

Here, the evidence at trial will undoubtedly overlap in each separate proceeding given the similarity of the marks and the identical or substantially similar legal arguments by the Opposers and by Applicant.

If the two proceedings are not consolidated, then the parties will have to take and enter repetitive testimony and evidence in separate cases, file repetitive sets of briefs, and prepare for separate trials on similar issues. The Board might appoint separate panels to hear the respective

claims. Consequently, the Board would have to waste its resources reviewing the same record, reading similar briefs, and preparing for duplicative trials.

Furthermore, the conflicting claims of priority at issue in these proceedings provide context for one another and should be evaluated simultaneously in order to reach a single consistent result. If the two proceedings are not consolidated, then there is a risk of inconsistent decisions by the Board on each of the key questions cited above.

None of the parties will be prejudiced by consolidation, given the very early stage of each of the two proceedings. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. TBMP § 511.

F. CONCLUSION

For the foregoing reasons, Dropbox therefore respectfully requests that the Board grant its motion to consolidate Opposition No. 91200450 and 91201367 and reset the dates for the discovery and trial periods in these proceedings. Dropbox also respectfully requests that the Board suspend these proceedings pending disposition of this motion.

Dated: February 7, 2012

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /John L. Slafsky/
John L. Slafsky
Evan M. W. Stern

Attorneys for Applicant
DROPBOX, INC.

Please address all communications concerning this proceeding to:

John L. Slafsky
Evan M. W. Stern
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650 Page Mill Road
Palo Alto, California 94304-1050
Telephone: (650) 493-9300
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trademarks@wsgr.com

CERTIFICATE OF SERVICE BY MAIL

I, Lisa Ruiz, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served this **RENEWED MOTION TO CONSOLIDATE** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

James L. Vana
Perkins Coie, LLP
1201 3rd Avenue Suite 4800
Seattle, WA 98101-3099

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on February 7, 2012.

/Lisa Ruiz/

Lisa Ruiz

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)	Serial No. 77817716
v.)	
)	
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Applicant.)	
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DECLARATION OF JOHN L. SLAFSKY

1. I am a member of Wilson Sonsini Goodrich & Rosati, P.C., counsel to Applicant Dropbox, Inc. (“Dropbox”) in this matter. I have personal knowledge of the facts in this declaration, and, if called as a witness, I could competently testify to them.

2. I met and conferred with counsel to YouSendIt, Inc. (“YouSendIt”) on January 30, 2012. I communicated Dropbox’s intent to file a renewed motion to consolidate. I stated Dropbox’s view that having both oppositions proceed through discovery and to trial on the same schedule, and then having both oppositions heard by the same Board panel, would be most efficient and would help mitigate the risk of inconsistent decisions by the Board. I also stated Dropbox’s view that designation of lead opposition counsel for both oppositions is not necessary. In response, counsel to YouSendIt stated its position that it does not intend to oppose this motion, but that it would not enter into any stipulation.

3. I met and conferred with counsel to Box.net, Inc. (“Box.net”) on February 1, 2012. I communicated Dropbox’s intent to file a renewed motion to consolidate. I stated Dropbox’s view that having both oppositions proceed through discovery and to trial on the same schedule, and then having both oppositions heard by the same Board panel, would be most efficient and would help mitigate the risk of inconsistent decisions by the Board. I also stated

Dropbox's view that designation of lead opposition counsel for both oppositions is not necessary. Counsel to Box.net stated that he would need further direction from his client. I subsequently followed up with counsel to Box.net concerning Box.net's position, but Box.net did not respond or otherwise state a position.

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on February 7, 2012.

By: /John L. Slafsky/

John L. Slafsky

CERTIFICATE OF SERVICE BY MAIL

I, Lisa Ruiz, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served this **DECLARATION OF JOHN L. SLAFSKY** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

James L. Vana
Perkins Coie, LLP
1201 3rd Avenue Suite 4800
Seattle, WA 98101-3099

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